

REMARKS

Claims 1-7 and 19-21 remain pending in the present application.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Claim Rejections under 35 U.S.C. § 103

Claims 1-3, 19, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA (the admitted prior art) and further in view of Fujiki US '094 (US 5,438,094), Ichikawa US '495 (US 6,501,495), and Takuman EP '211 (EP 1225211). Further, claims 1-7 and 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA and further in view of Tsuji EP '702 (EP 764702), Ichikawa US '495 and Takuman EP '211.

Applicants respectfully traverse. Reconsideration and withdraw of the rejections is respectfully requested based upon the following explanation.

Introduction (Response to "Response to Argument" at paragraph "5." of page 8 of the Office Action)

First of all, the present invention is not obvious over the combination of the cited references for the reasons: i) there is no rationale and/or reasonable expectation of success based on the combination of the cited references for one skilled in the art to reach the claimed invention; and ii) the claimed invention exhibits unexpected, advantageous results.

In this regard, the Examiner alleges at paragraph "5." of page 8 of the Office Action, as follows:

"Applicant argues that the claims are commensurate in scope with data in Examples as disclosed in the specification. The examiner agrees. However, the examples in Table 1 do not provide a conclusive showing of unexpected results for a composition satisfying each of the claimed loadings. In particular, the prior art broadly recognizes the known inclusion of a composition having each of the claimed inorganic fillers. The comparative examples, however, are completely devoid of aluminum hydroxide powder and thus, the criticality of the claimed range cannot be fairly discerned from Table 1 (none of the comparative examples positively include aluminum hydroxide, as suggested by the prior art, at a loading outside of the claimed range). It is suggested that applicant formulate comparative examples comprising aluminum hydroxide and silica, wherein the aluminum hydroxide loading is outside of the claimed range (less than 21.2 phr and greater than 37.2 phr)." (Emphasis added)

However, an applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987); *In re Chapman*, 357 F.2d 418, 148 USPQ 711 (CCPA 1966).

Here, neither of the cited references discloses such subject matter as the Examiner suggests in the Office Action. Namely, requiring such comparative examples comprising aluminum hydroxide and silica in the suggested amount (*i.e.*, outside of the claims) is to require Applicants to submit subject matter that does not exist in the prior art. Thus, the Examiner's suggestion goes against the case law.

Therefore, as explained below and in the previous response filed on May 8, 2009, Applicants sufficiently showed that the claimed invention exhibited unexpected, advantageous results based on the data of the 37 CFR § 1.132 Declaration of Mr. Hara filed on May 5, 2008

(the 132 declaration) and working examples as disclosed in the specification, in addition to that there is no rationale and/or reasonable expectation of success based on the combination of the cited references to reach the claimed invention.

Non-Obviousness over the Cited References

As recited in claim 1, the present invention employs an inorganic filler (iv) which comprises an aluminum hydroxide ($\text{Al}(\text{OH})_3$) and silica in a specific amount (i.e., an inorganic filler comprising an aluminum hydroxide in an amount of 21.3 to 37.2 parts by weight per 100 parts by weight of component (i), and silica in an amount of 14.1 to 15.6 parts by weight per 100 parts by weight of all the components excluding silica).

First, Takuman EP '211 discloses aluminum hydroxide ($\text{Al}(\text{OH})_3$). On the other hand, Fujiki US '094 and Tsuji EP '702 merely disclose alumina (Al_2O_3). It is noted that neither of Fujiki US '094, Tsuji EP '702 nor Takuman EP '211 discloses or suggests employment of aluminum hydroxide ($\text{Al}(\text{OH})_3$) in combination with silica.

Next, regarding the Ichikawa U.S. '495 reference, the Examiner states at page 3, lines 6-8 of the Office Action, as follows:

... metal oxides and metal hydroxides are commonly described as being suitable alternative in adhesive compositions, as shown for example by Ichikawa (Column 10, Lines 23-33).

In fact, the portion of Ichikawa US '495 as the Examiner specifically points out discloses, as follows:

In order to prevent deposition of scum on the thermal head, it is possible to use inorganic or organic filler in the thermosensitive adhesive agent layer. Examples of the filler include, but are not limited to, inorganic fillers such as calcium carbonate, silica, colloidal silica, zinc oxide, titanium oxide, aluminum hydroxide, zinc hydroxide, barium sulfate, clay, kaolin, talc, alumina, surface-treated calcium carbonate and silica or the like; and organic filler such as urea-formaldehyde resin, styrene-methacrylic acid copolymer, polystyrene resin and vinylidene chloride resin or the like. (Emphases added).

First, in the disclosure of Ichikawa US '495, an aluminum hydroxide and an alumina (aluminum oxide) are merely listed among many kinds of inorganic and organic filler (*i.e.*, mere "laundry list"). There is no suggestion to elect aluminum hydroxide instead of alumina. Namely, there is no rationale for one skilled in the art to choose aluminum hydroxide out of the laundry list.

Second, Ichikawa US '495 discusses these compounds in the laundry list as additives to prevent deposition of scum on the thermal head. Thus, Ichikawa US '495 fails to disclose or suggest that employment of an aluminum hydroxide (in combination with silica) attain excellent properties in adhesion (*e.g.*, peel strength, cohesive failure and inflation test adhesion), which the present invention exhibits as explain below.

In determining obviousness, the Examiner has to provide some rationale for determining obviousness, as established in the recent decision of *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

The rationale should be made explicit, *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007), and the Examiner must interpret the reference as a whole and cannot pick and choose only those selective portions of the reference which support the Examiner's position. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention."). Combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable to one of ordinary skill in the art. *United States v. Adams*, 383 U.S. 39, 51-52, 148 USPQ 479, 483-84 (1966); *see also* M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, there is no rationale and/or reasonable expectation of success based on combination of the cited references for one skilled in the art to arrive at the significant feature of the present invention (*i.e.*, employment of aluminum hydroxide (Al(OH)₃) in combination with silica).

Additionally, none of the cited references discloses or suggests the claimed amounts of aluminum hydroxide and silica.

Therefore, as explained above, there is no reasonable expectation of success and/or rationale based on the cited references and AAPA for one skilled in the art to arrive at the present invention. Thus, the claimed invention is not obvious over the combination of the cited references.

Unexpected Results

In the previous responses to the Office Actions filed on January 2, 2009 and May 8, 2009, it was explained that the use of aluminum hydroxide ($\text{Al}(\text{OH})_3$) and silica as (iv) an inorganic filler, as recited in claim 1, can attain excellent properties in adhesion (e.g., peel strength, cohesive failure and inflation test adhesion), based on the data of the 132 declaration, which was enclosed with the previous submission of May 5 2008, and the working Examples of the specification. Such data is commensurate in scope with the claims, as the Examiner agrees thereto (see paragraph "5." of page 8 of the Office Action.)

However, the Examiner alleges at paragraph "5." of page 8 of the Office Action, as follows:

"Applicant argues that the claims are commensurate in scope with data in Examples as disclosed in the specification. The examiner agrees. However, the examples in Table 1 do not provide a conclusive showing of unexpected results for a composition satisfying each of the claimed loadings. In particular, the prior art broadly recognizes the known inclusion of a composition having each of the claimed inorganic fillers. The comparative examples, however, are completely devoid of aluminum hydroxide powder and thus, the criticality of the claimed range cannot be fairly discerned from Table 1 (none of the comparative examples positively include aluminum hydroxide, as suggested by the prior art, at a loading outside of the claimed range). It is suggested that applicant formulate comparative examples comprising aluminum hydroxide and silica, wherein the aluminum hydroxide loading is outside of the claimed range (less than 21.2 phr and greater than 37.2 phr)."
(Emphases added)

However, as explained above, none of the cited references disclose or suggest that aluminum hydroxide is employed in combination with silica to attain excellent properties in adhesion (e.g., peel strength, cohesive failure and inflation test adhesion).

Even Ichikawa US '495, which the Examiner alleges to disclose that metal oxides and metal hydroxides are commonly described as being suitable alternative in adhesive composition, fails to disclose or suggest that use of aluminum hydroxide in combination with silica attains the excellent properties in peel strength, cohesive failure and inflation test adhesion. At best, Ichikawa US '495 would suggest that metal oxides and metal hydroxides were equivalent alternative as a filler for an adhesive composition. So, what one skilled in the art expects based on Ichikawa U.S. '495 in combination with the other cited reference is that, at best, silicone rubber composition containing aluminum hydroxide (instead of aluminum oxide) would have the same (or similar) properties as silicone rubber composition containing aluminum oxide, when employed as an air bag sealer silicone composition. In short, what one skilled in the art expects based on the cited references is, at best, that there is no difference in properties between aluminum oxide and aluminum hydroxide. However, one skilled in the art cannot expect that an aluminum hydroxide containing silicon rubber exhibits better properties than aluminum oxide containing silicon rubber based on the cited references.

In this regard, Applicants submitted the 132 declaration of Mr. Hara. As evident from the data of the 132 declaration, use of aluminum hydroxide or use of aluminum hydroxide in combination with the specific reinforcing or non-reinforcing filler such as fumed silica as (iv) an inorganic filler according to the present invention can attain excellent properties on adhesion

(peel strength, cohesive failure, and inflation test adhesion) as compared with the use of fumed silica alone or the combination of aluminum oxide (alumina) and fumed silica.

Accordingly, so long as inorganic filler contains aluminum hydroxide in an amount of 21.3 to 37.2 parts by weight per 100 parts by weight of the alkenyl group-containing organopolysiloxane, and silica in an amount of 14.1 to 15.6 parts by weight per 100 parts by weight of all the components excluding silica, as recited in the claims, unexpected and remarkable effects on adhesion properties can be attained by using aluminum hydroxide. It is noted that as explained above, such advantageous properties of the present invention cannot be expected from the combination of the cited references because, at best, it would be expected from the combination of the cited references that the use of aluminum hydroxide imparted substantially the same adhesion properties as the use of aluminum oxide (alumina).

Therefore, the 132 declaration, *etc.*, which were already provided, sufficiently prove that the excellent properties of the claimed invention are unexpected from the combination of the cited references.

Incidentally, the experimental data of the 132 declaration do not intend to merely show that the composition having 21.3 to 37.2 parts by weight of aluminum hydroxide blended therein can selectively impart an excellent adhesion properties as compared with the compositions containing aluminum hydroxide out of the inventive amount range, but do intend to show the superiority of the inventive composition, *i.e.*, the improved adhesion of the aluminum hydroxide-containing composition is unexpectedly remarkable as compared with that of the aluminum oxide-containing composition. (Again, it is noted that it would be expected from the prior art that the improved adhesion properties of the aluminum hydroxide-containing composition were

substantially equal to the same of the aluminum oxide containing composition, at best. It cannot be expected that aluminum hydroxide-containing composition exhibits better properties.)

Further, it is noted that the reason why the amount of aluminum hydroxide was specified to 21.3 to 37.2 parts was due to the Examiner's indication that data in the specification and the 132 declaration was not commensurate in scope with the amount range of aluminum hydroxide in the previous claims (see page 9, lines 9-12 of the Office Action of February 10, 2009 and page 9 of Amendment of May 8, 2009). Thus, to response to the Examiner's comments, Applicants amended the claims in Amendment filed May 8, 2009 so that the claims were commensurate in scope with the data (while not conceding to the Examiner's position, but to merely advance prosecution). Therefore, by the amendment, Applicants did not mean that the present invention was patentable only because the amount range of 21.3 to 37.2 parts of aluminum hydroxide has criticality.

In this regard, in determining patentability of the claimed invention, the Examiner requires the criticality of the claimed range in an arbitrary manner, while ignoring disclosure, suggestion and teaching in the prior art and the case law. Thus, the Examiner's position cannot be accepted. Also, Applicants respectfully submit that the Examiner's position to require Applicants to submit additional data which does not exist in the prior art unduly imposes burden of proof of patentability on Applicants, as explained at the beginning.

As explained above, it is evident, from the data of the 132 declaration and the Examples and Comparative Examples in the specification, that the use of aluminum hydroxide and silica in the specific amount as (iv) an inorganic filler, as recited in the claims, can attain excellent

properties in adhesion (*e.g.*, peel strength, cohesive failure and inflation test adhesion), as compared with the use of silica alone or in combination with aluminum oxide (alumina).

Accordingly, even if a *prima facie* case of obviousness has been properly alleged, such obviousness has been rebutted by the evidence of unexpected, advantageous properties discussed above.

In view of the above, the present invention patentably defines over the cited references. Applicants respectfully request that the Examiner withdraw the above rejections.

Provisional Request for Interview

Should the present response not place the application in condition for allowance, Applicants respectfully request a personal interview with the Examiner. The Examiner is respectfully requested to contact the undersigned with regard to scheduling a personal interview with the Examiner.

CONCLUSION

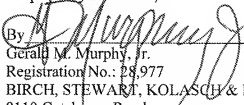
Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims is allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Toyohiko Konno, Reg. No. L0053 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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